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HAGEMAN, MARK

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE K. ZELLER

Appeal 2009-3405
Application 10/823,113
Technology Center 3600

Decided¹: May 28, 2009

Before LINDA E. HORNER, DANIEL S. SONG, and
FRED A. SILVERBERG, *Administrative Patent Judges*.

SONG, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The Appellant appeals under 35 U.S.C. § 134 from a Final Rejection of claims 22-27. Claims 1-8 have been canceled, and claims 9-21 have been withdrawn from consideration. We have jurisdiction over this appeal under 35 U.S.C. § 6(b) (2002).

The claimed invention is directed to a frame for separating excavated material, the frame including a grate rigidly secured to, and extending from, vertical bar members to a front wall (Spec. ¶¶ [0025], [0026]; fig. 1).

Independent claims 22 and 25 are representative of the claimed invention and read as follows (App. Br., Claims App'x.; emphasis added):

22. A frame for separating excavated material comprising:
a base having a front wall and two horizontal side bars extending backward from opposite sides of a bottom of said front wall;
at least one vertical bar member extending vertically upward from a top of each of said horizontal side bars at an end of said horizontal side bars opposite said front wall; and
a grate rigidly secured to, and extending from, a top of said vertical bar members to a top of said front wall such that said grate forms less than a ninety degree angle relative to a ground surface.
25. A frame for separating excavated material comprising:
a base having a front wall and two side walls;
at least one bar member extending vertically upward from each of said side walls; and
a grate rigidly secured to, and extending from, a top of said bar members to a top of said front wall such that said grate forms less than a ninety degree angle relative to a ground surface.

The Examiner relies upon the following as evidence of unpatentability:

Wall	US 1,005,907	Oct. 17, 1911
Nierop	US 2004/0020830 A1	Feb. 5, 2004
		(filed Jul. 31, 2002)

The Examiner rejected claims 22, 24-25, and 27 under 35 U.S.C. § 102(e) as anticipated by Nierop.

The Examiner rejected claims 23 and 26² under 35 U.S.C. § 103(a) as unpatentable over Nierop and Wall.³

We REVERSE.

ISSUES

1. Has the Appellant shown that the Examiner erred in finding that Nierop describes a grate rigidly secured to, and extending from, the top of the vertical bar members to a top of the front wall as recited in independent claims 22 and 25?
2. Has the Appellant shown that the Examiner erred in concluding that it would have been obvious to one of ordinary skill in the art to combine

² Dependent claim 26 erroneously depends from itself. It appears that claim 26 should depend from independent claim 25 since claim 26 follows claim 25 and further defines a limitation (“side wall”) found only in claim 25 (37 C.F.R. § 1.175(f)). Therefore, claim 26 has been treated as being dependent on claim 25 in this appeal. This error should be corrected in any future prosecution.

³ The following rejections have been withdrawn by the Examiner:

1. The rejection of claims 25-27 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-3 of U.S. Patent No. 6,863,182; and
 2. The rejection of claims 22 and 25 under 35 U.S.C. § 102(b) as anticipated by Bane (US 359,659).
- (Ans. 2-3).

the teachings of Nierop and Wall to result in the invention of claims 23 and 26?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Nierop describes a soil screening device with an upper screen frame member 16a that is pivotally mounted, by means of hinges 18, to an upper cross bar 20a (§ [0016]; fig. 2).
2. Nierop further describes “[t]he screen frame is pivotally mounted to a first upper member mounted at an upper end of the uprights, for pivoting between a lowered position and an elevated position” (§ [0005]).
3. Wall describes an ore screening device where “upper and lower bars b^2 , b , are braced together by the inclined braces b^4 ”, and the upper bars b^2 are supported by the uprights b^3 (p. 1, ll. 31-41; fig. 1).

PRINCIPLES OF LAW

Anticipation under 35 U.S.C. § 102 is a question of fact. *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *see also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *See Oetiker*, 977 F.2d at 1445; *see also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *Oetiker*, 977 F.2d at 1445.

“Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art.” *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims “their broadest reasonable interpretation consistent with the specification” and “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

ANALYSIS

Initially, the Appellant argues that his claim to priority presented by way of (1) Preliminary Amendment filed on April 13, 2004, and (2) Amendment and Response to Office Action filed on September 18, 2006, disqualifies Nierop as prior art (App. Br. 7; Reply Br. 2-3). The Appellant requests that the Board find that his priority claim is properly perfected (Reply Br. 3). However, as correctly noted by the Examiner (Ans. 2), whether the Appellant has properly perfected his priority claim is reviewable by petition under 37 C.F.R. § 1.181. Such issues are not within the jurisdiction of the Board. *See In re Mindick*, 371 F.2d 892, 894 (CCPA 1967). Accordingly, this issue can not be treated in this appeal.

Anticipation rejection over Nierop

Turning to the substantive arguments, the Appellant argues that Nierop does not describe a grate rigidly secured to, and extending from, the top of the vertical bar members to a top of the front wall, as set forth in independent claims 22 and 25 (App. Br. 7). In support of this argument, the Appellant proffers several dictionary definitions for the term “rigidly” which include “deficient in or devoid of flexibility,” “stiff or unyielding; not pliant or flexible; hard,” and “firmly fixed or set” (Reply Br. 3, Exhibit C). According to the Appellant, in light of the proffered dictionary definitions, the limitation “rigidly” in the claims require “a grate that is inflexible and firmly fixed or set to a top of the vertical bar members and to a top of the front wall” (Reply Br. 3).

The Examiner's position is that Nierop discloses a rigidly secured grate member that satisfies the limitations of independent claims 22 and 25 because:

...Nierop teaches the grate member (14) firmly seated on a rigid frame (Fig. 1, 2; para. 16 teaching rigid frame members 16, 20, 30). As prior art is interpreted as broadly as reason allows, it is not unreasonable to regard the grate member as firmly secured as Nierop teaches that the surrounding frame structure is rigid and the device itself relies on the grate being rigidly held during screening (para. 15 [*sic*] teaching a rigid screen mounted on top of a rigid support frame). In view of Nierop's express teachings, the use of a hinge connection to connect a top portion of the grate can be simply be regarded as another means that assists in forming a rigidly secure connection.

(Ans. 6).

Thus, the Examiner finds that Nierop's "upper screen frame member 16a pivotally mounted, by means of hinges 18 to an upper cross bar 20a" satisfies the claimed frame apparatus.

The Examiner is correct that during prosecution, claims are to be given their broadest reasonable construction in light of the Specification as it would be interpreted by one of ordinary skill in the art. *See In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d at 1364. However, for the reasons that follow, we find the Examiner's construction of the limitation "rigidly" to be unreasonable.

While we acknowledge that the individual *components* of the frame of Nierop may be considered to be "rigid" in that they are not flexible, the claims require the securement of the grate to be rigid. Thus, we construe the limitation "rigidly secured to" to mean that the recited securement must

result in a grate that is immovable and fixed, which is consistent with the definitions of “rigid” proffered by the Appellant.

In particular, considering the Appellant’s Specification, the following disclosure is relevant:

The frame member 10 is preferably comprised of a rigid and durable metal such as, but not limited to, steel and the like. All elements which comprise the frame member 10 are welded together to ensure the integrity of the structure which comprises frame member 10. (Spec. ¶ [0026]).

Hence, our construction of the limitation “rigidly secured to” is consistent with the Specification’s description of the claimed invention. Therefore, we find the Examiner’s construction of the limitation “rigidly” to encompass a pivotably hinged connection to be unreasonable.

Although Nierop’s hinge 18 does not allow separation of the upper screen frame member 16a from the surrounding frame structure, it does allow substantial movement thereof which is the purpose of the hinge. Hence, Nierop does not describe a grate that is rigidly secured as recited in claims 22 and 25, i.e., an immovably fixed grate.

In view of the above, because Nierop does not describe all the elements of independent claims 22 and 25, the Examiner’s rejection of claims 22, 24-25, and 27 as anticipated by Nierop is not sustained.

Obviousness rejection over Nierop and Wall

The Examiner rejected claims 23 and 26 as obvious over the combination of Nierop and Wall. The Examiner’s rejection is based on the finding that Nierop describes all of the claimed limitations except for the support bar “extending from a top of each of said horizontal side walls to a

mid-length of the grate on opposite sides of said grate” for which Wall is relied upon (Ans. 5).

However, the Examiner’s application of Wall does not cure the deficiency of Nierop discussed *supra* relative to independent claims 22 and 25 from which claims 23 and 26 respectively depend. Therefore, the Examiner’s obviousness rejection as set forth in the Answer is not sustained.

CONCLUSIONS

1. The Appellant has shown that the Examiner erred in finding that Nierop describes a grate rigidly secured to and extending from the top of the vertical bar members to a top of the front wall as recited in independent claims 22 and 25.

2. The Examiner’s application of Wall to Nierop does not cure the noted deficiencies of Nierop.

DECISION

1. The Examiner’s rejection of claims 22, 24-25, and 27 under 35 U.S.C. § 102(e) as anticipated by Nierop is REVERSED.

2. The Examiner’s rejection of claims 23 and 26 under 35 U.S.C. § 103(a) as unpatentable over Nierop and Wall is REVERSED.

REVERSED

Appeal 2009-3405
Application 10/823,113

ack

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